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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,298	09/25/2000	Salcem Ahmad	HA0744 NP	2733

23914 7590 04/16/2003

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EXAMINER

LIU, HONG

ART UNIT PAPER NUMBER

1624

DATE MAILED: 04/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n N .

09/669,298

Applicant(s)

AHMAD ET AL.

Examin r

Hong Liu

Art Unit

1624

--The MAILING DATE of this communication appears n th cover sheet with the c rrespondenc address --

THE REPLY FILED 21 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See the attached advisory action.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 28-30 and 63.

Claim(s) objected to: 6,9,10,14,25-27,65,67,68,72 and 74.

Claim(s) rejected: 1-3,8,15,17,19,22,24,31,64,66,70,71 and 73.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

SECOND ADVISORY ACTION

The after final amendment filed on 03/21/03 cannot be entered since while narrowing the scope of previously rejected claims at Z to pyrimidine to overcome the 102 rejection, it expands the scope of Z in the newly added claims 75 and 76 to include Z is a 5- to 6-membered nitrogen-containing heteroaryl group. This would necessitate further consideration and search to determine the applicability of additional art which would render the amended claims anticipated or obvious under 35 USC 103. The original search was based on applicants' elected species. Once the elected species was found to be anticipated or rendered obvious by prior art, the search was stopped and the elected species was rejected. Therefore, in order to determine the patentability of the whole genus of the newly amended claim 1 and the newly added claims 75 and 76, further searches are required. Although claims 9, 10, 14, 25-27, 65, 67, 68, 72, and 74 were indicated to be objected to in the Office Action Summary, the patentability of these claims were not determined because the structure search never reached these claims. These claims were listed in the Office Action Summary in the final rejection as being objected to mainly because the 112, first paragraph, rejections to these claims were withdrawn in view of applicants' amendment. However, because the structure search was based on election of species, these claims were withdrawn from prior art consideration once prior art directed to other broader claims was found. In order to determine the patentability of these claims, further search is required.

In addition, claims 75 and 76 are anticipated by Farina et al.

Applicants are reminded that entry of amendment after final rejection is not a matter of right. "Except where an amendment merely cancels claims, adopts examiner suggestions, remove issues for appeal, or is some other way only a cursory review by the examiner, compliance with

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the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final reelection." See MPEP 714.13. For these reasons, this amendment after final rejection will not be entered.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl
April 11, 2003



RICHARD L. RAYMOND
FEDERAL BUREAU OF INVESTIGATION

Mukund Shah
Supervisory Patent Examiner
Art Unit 1624